

REMARKS

Claim 26 has been canceled and its features have been incorporated into independent claim 7.

Claims 1-25 are pending.

In the Office action, claims 1-6 and 14-26 were rejected as unpatentable over U.S. Patent No. 6,311,165 (Coutts) in view of U.S. Patent No. 6,449,253 (Ott). Claims 7-13 were rejected as unpatentable over the Coutts patent in view of U.S. Patent No. 6,318,536 (Korman).

Independent claim 1 recites a value transaction system including transaction units and a controller that is operable to *upload* run-time interpreted code units from the transaction units. The controller can execute the code of each respective code unit and generate signals to control the operation of the respective transaction units. Independent claims 7, 14, 22 and 25 recite similar features.

Such an arrangement may provide the advantage that a new unit of completely arbitrary type can be added to an existing transaction system and function correctly with the other units under the control of a central controller in which the software units are integrated to facilitate information exchange. That may be accomplished without requiring either (a) an on-line system with a central, remote software-storing server or (b) a system that incorporates high-powered "intelligent" transaction units (*see, e.g.*, Specification, page 2, line 21 - page 3, line 6).

The Coutts patent relates to networked transaction systems having a central server and a terminal having a number of peripheral devices, such as a cash dispenser, card reader, etc. The systems disclosed by the Coutts patent have peripheral devices that download software from the central server and execute their own software. For example, the Coutts patent discloses:

[T]he server is arranged to store applications and driver or other operational software for the peripheral devices and communication links can be provided

from the server to individual peripheral devices to enable such software to be
downloaded from the server to the device.

* * *

With the disclosed architecture, appropriate software can be readily *downloaded from server 16* through link 17 at run time without the need to store every alternative driver program at the dispenser.

(Col. 3, lines 58-62; col. 11, lines 6-9) (Emphasis added)

Indeed, the office action acknowledges that the Coutts patent “does not disclose a controller that is operable to upload from the transaction units respective run-time interpreted code units for storing in the memory or separately loading executable code for the respective code modules from the associated transaction unit into the memory means of the controller.”

Nevertheless, the Office action cites the Ott patent as allegedly disclosing those features.

The Law of Obviousness

A claimed invention is unpatentable due to obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art.” 35 U.S.C. § 103(a).

As discussed by the Court of Appeals for the Federal Circuit, a proper conclusion of obviousness under 35 U.S.C. § 103 requires that there be some motivation in the prior art that suggests the claimed invention as a whole:

[A]n Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for

piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

[Citations omitted] To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness.

In re Rouffet, 149 F.3d 1350, 1357; 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998). As further explained by the Federal Circuit:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” Id.

“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

Ecolochem, Inc. v. Southern California Edison Co., 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000).

Furthermore, the showing of the motivation to combine must be “clear and particular.”

See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 63 USPQ2d 1374 at 1387 (Fed. Cir. 2002).

Claims 1-25 are patentable over the cited references

Even if the Ott patent did show *uploading* of code from transaction units, that feature is directly contrary to the techniques described in the Coutts patent, which is directed to *downloading* of code from a central server 16. Furthermore, according to the Coutts patent, the downloaded code is used to control operations of the peripheral device which downloads the software from the central server. Therefore, even if the Ott patent disclosed uploading software, there would have been absolutely no motivation to apply such techniques to the system disclosed by the Coutts patent. In particular, there would have been no motivation for *uploading* executable code *from* the individual peripheral devices (*e.g.*, card reader 13, receipt printer 14, cash dispenser 15) in the Coutts patent *to* the central server 16. Thus, there would have been no motivation to obtain the subject matter of the pending claims, including a “controller operable to *upload from* said transaction units respective run-time interpreted code units for storing in said memory means, the controller being operable to execute the code of each respective code unit and in response thereto to generate signals controlling the operation of the respective transaction units,” as recited in claim 1. Nor would there have been any suggestion of the similar features recited in claims 7, 14, 22 and 25.

Furthermore, the Ott patent does not disclose uploading of code *from a transaction unit* to a controller. The passage cited by the Office action (col.3, lines 39-51) is irrelevant, although applicant notes that a different passage in the Ott patent does refer to uploading software in connection with FIG. 3:

Controller 390 interfaces with memory unit 360 and secondary storage 380 via high speed buses 370 and 371, respectively.

* * *

Secondary storage 380 includes disk drive unit 382 and tape cartridge 381. Stored in disk drive unit 382 are software and data for switching system 105₂. For example, disk drive unit 382 contains software for VC_Handler 320, Port_Handler 330, Bandwidth_Allocation_Update 340, and Buffer 350. Secondary storage 380 can copy software and data for switching system 105₂ from tape cartridge 381 into disk drive unit 382. Controller 390 can then upload the software and data from disk drive unit 382 into memory unit 360. Similarly, controller 390 can download software and data from memory unit 360 into disk drive unit 382. Secondary storage 380 can then copy the downloaded software and data from disk drive unit 382 into tape cartridge 381.

(col. 7, lines 14-16 and 39-51) That passage simply makes it clear that software and data can be transferred between memory 360, disk drive 382 and tape cartridge 381. Although the memory 360 can store software for various components (e.g., VC_Handler 320), the memory is not part of or associated with those components. In other words, the Ott patent only discloses the storage of code in conventional storage devices. There is no suggestion of storing code in a *transaction unit* for upload to the controller to allow the controller execute the code of each respective code unit and in response thereto to generate signals controlling the operation of the respective transaction units.

In summary, there would have been no “clear and particular” motivation to combine the Coutts and Ott patents to obtain the subject matter of claims 1-25. In view of the foregoing remarks, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1-25.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or

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other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Enclosed is a check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 9/23/05

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